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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,777	05/04/2001	Zuheir L. Audeh	CBR-001XX	6632
7590 08/19/2004			EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & HAYES LLP			PADMANABHAN, KARTIC	
Ten Post Office Square			ART UNIT	
Boston, MA 02109			PAPER NUMBER	
			1641	
DATE MAILED: 08/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/848,777

Applicant(s)

AUDEH ET AL.

Examiner

Kartic Padmanabhan

Art Unit

1641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 6-16, 18-21 and 30-32.

Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: the proposed amendment adds new claims with limitations that were never previously considered. For example, method claims were never previously considered. In addition, applicant has proposed to add the new limitation of requiring the composition to include a blocking biomolecule.

Continuation of 5. does NOT place the application in condition for allowance because: of reasons set forth in the previous office action. Applicant's arguments with respect to the newly proposed claims are moot, as the amendment has not been entered or considered. In addition, applicant's arguments with respect to the difference in size have been addressed in the previous office action, and any alleged advantages of the size of the present invention that would render the claimed invention unobvious over the prior art should be submitted in the form of a declaration. Applicant's arguments with respect to the differences between proteins and oligonucleotides, thus rendering the combination of Van Ness and Grieve inappropriate, are not convincing. The present claims are drawn to a composition, so any differences in terms of manipulation of the different molecules are not deemed relevant to the patentability of the composition, and may only be relevant for method claims. In addition, there is no requirement in the claims of maintenance of a molecule's 3-dimensional shape. Applicant argues that Nagai does not teach forming beads for attachment to a biomolecule, but the examiner maintains that the combination of Grieve and Nagai do. In terms of Delair, the examiner agrees that the reference does not teach the matrix material of the present claims, but Grieve cures this deficiency. In addition, while Delair may indeed use their beads for a different purpose than the claimed invention, the intended use does not merit patentable weight. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In terms of Kawaguchi, the examiner agrees that the reference does not teach the matrix material of the present claims, but Grieve cures this deficiency. Applicant's arguments with respect to Seul are similarly unconvincing for reasons of record.

Mary E. Ceperley

MARY E. CEPERLEY
PRIMARY EXAMINER

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acting SPE